

REMARKS

Claims 1 and 3-13 remain in the application. Claim 2 has been cancelled. Claims 1, 5, and 9-13 have been amended. Applicant respectfully requests reconsideration in light of the amendments and the following remarks.

CLAIM REJECTIONS UNDER 35 USC §101

The Office Action rejected claims 5-11 and 13 under 35 USC 101 as directed to non-statutory subject matter. The subject matter patentability analysis begins with the statute. Section 101 provides:

“Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.”

Excluded from patent protection are laws of nature, physical phenomena, and abstract ideas. *Diamond v. Diehr*, 450 U.S. 175 (1981). It is improper to read limitations into § 101 on the subject matter that may be patented where the legislative history indicates that Congress clearly did not intend such limitations. See *Chakrabarty*, 447 U.S. at 308 (“The Federal Circuit has also cautioned that courts ‘should not read into the patent laws limitations and conditions which the legislature has not expressed.’” (citations omitted)). State Street Bank & Trust Co. v. Signature Fin. Group, 149 F.3d 1368 (Fed. Cir. 1998).

The Office Action improperly reads into section 101 the limitation that claims must be limited to tangible embodiments. That is not one of the judicially recognized exclusions from patentable subject matter. For that reason alone the rejection should be withdrawn. However, the computer readable medium of claim 5 is limited to physical embodiments. Consider for example a computer that has no word processing capability. A CD ROM comprising an “intangible” program is inserted into the computer and the “intangible” software is loaded into the computer. The computer now has the capability to produce and edit text files. Now, the CD is removed but the computer still has word processing capabilities. This is a tangible embodiment. It’s not the CD that caused that; it’s the software written on the CD that made it work. Next, consider that the computer had an Internet connection. The user of the computer downloads a copy of a word processing program. The computer now processes text. That is also a tangible result. The rejection should therefore be withdrawn.

The Office Action improperly reads another limitation into section 101: to be patentable something must be a “physical thing.” The word “physical” is defined as “Of or pertaining to matter and energy or the sciences dealing with them.” The American Heritage Dictionary, Second College Edition, Houghton Mifflin (1982). Undeniably, computer programs transmitted by CD or by wire meet this definition of physical.

The Office Action then says that computer programs are not statutory processes and they are not acts. Admittedly processes and acts are patentable subject matter but they are not physical

things either, unless one considers the effects of an object as a physical thing. As was discussed above, the downloading of software does something physical to the computer that makes it behave differently from when the software was downloaded.

Claim 9 has been amended to be in the machine category of patentable subject matter and thus its rejection is now moot. Therefore, the Office Action has not provided any valid legal reason for its rejection and as such it must be withdrawn.

CLAIM REJECTIONS UNDER 35 USC §112

The Office Action rejected claims 1, 5 and 9 under 35 USC 112, second paragraph, as being indefinite on the grounds that Applicant has not allegedly made clear what the term “cost-related information” is meant to encompass. Therefore, the claims have been amended to state that cost-related information comprises the kind of use that is made of the component or corresponding decisions made for other components that interact with the component. Support for this amendment is found at page 2, paragraph 29 of the disclosure. Therefore, the rejection has been overcome.

PROVISIONAL DOUBLE PATENTING CLAIM REJECTIONS

The Office Action provisionally rejected claims 1 and 5 on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 13 and 19 of co-pending application number 10/073,628.

The Office Action provisionally rejected claims 1 and 5 on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 2 and 7 of co-pending application number 10/073,608.

Therefore, Applicant is filing terminal disclaimers for a term running beyond that of patent applications 10/073,628 and 10/073,608.

CLAIM REJECTIONS UNDER 35 USC §103

The Office Action rejected claims 1-13 under 35 USC 103(a) as being unpatentable over “Dynamic Program Monitoring and Transformation Using the OMOS Object Server” by Orr et al. (“Dynamic Program Monitoring”) in view of “Program Specialization Using the OMOS System” by Orr et al. (“Program Specialization”).

Dynamic Program Monitoring teaches:

“The monitor procedures send an event trace back to OMOS, which analyzes this information to derive a desired ordering of procedures within the executable. Then OMOS reorders the base executable; subsequent instantiations use the new, optimized version.”

This is not the same as instrumenting said components to gather cost-related information during at least a partial run of said program. The quoted language does not state the criteria used for ordering of procedures. To assume, as the Office Action does, that the ordering is done in order of cost estimates is improper because it is an improper use of hindsight. The use of cost does not appear in the prior art; instead it is taught and claimed by Applicants. That is not the use of information available at the time of the invention and is therefore hindsight.

In addition, the cited combination does not teach or suggest the claim limitation of claims 1, 5, and 9, added by amendment, that cost-related information comprises the kind of use that is made of the component or corresponding decisions made for other components that interact with the component.

Moreover, the Office Action admits that Dynamic Program Monitoring does not disclose selecting, at runtime, one of the explicitly selectable implementations. However it contends that Program Specialization teaches this claim limitation. Program Specialization discusses I/O implementations which is not what Dynamic Program Monitoring discusses. In fact the Office Action contends that Dynamic Program Monitoring teaches all of the steps of claim 1 but then does not select one of the implementations. In other words, the Office Action contends that Dynamic Program Monitoring gathers cost-related information and orders various implementations but does not choose among the ordered procedures. Program Specialization does not teach, suggest or motivate the modification of Dynamic Program Monitoring as suggested by the Office Action. In fact Applicant asserts that either Dynamic Program Monitoring or Program Specialization must be considered objective evidence of non-obviousness. If the reason for making the combination used by the Office Action were valid then one or the other publication would have disclosed the subject matter of claim 1 (or the other independent claims). In fact neither of the references disclosed the entire subject matter of any claim of the instant application. If they had they would be referenced as anticipating prior art

and they were not. The failure of either reference to disclose the entirety of the claimed subject matter must be considered evidence of the failure of others which is objective evidence of non-obviousness. If we accept the reason for making the combination of references used by the Office Action then the cited publications are indeed evidence that there was a problem unsolved by those skilled in the art and that the cited publications were prior failures. Applicant's contribution is the solution of the problem recognized by the Office Action but not solved by either of the cited publications. Thus, failure of others to provide a feasible solution to the long-standing problem recognized by the Office Action is probative of non-obviousness. *Intel Corp. v. USITC*, 946 F.2d 821 (Fed. Cir. 1991). Objective evidence of non-obviousness must be considered when present (as here). *Hybritech inc. v. Monoclonal Antibodies, Inc.* 802 F.2d 1367 (Fed. Cir. 1986). Therefore the obviousness rejections should be withdrawn.

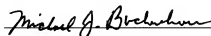
Claims 3-4 and 12-13 are dependent on claim 1 and are patentable for at least the foregoing reasons. Claim 5 is an article of manufacture counterpart of claim 1 and is patentable for the foregoing reasons. Claims 6-8 are dependent on claim 5 and are patentable for at least the same reasons.

Claim 9 is a computer system that comprises limitations substantially the same as those argued above. Claims 10 and 11 depend on claim 9 and are patentable for at least the same reasons as claim 9 is patentable.

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For the foregoing reasons, Applicant respectfully requests allowance of the pending claims.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read "Michael J. Buchenhorner", is written over a horizontal line.

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